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DEC 14 2010

In re Application of :
Underwood, et al. :
Application No. 09/651,907 :
Filed: August 30, 2000 :
Attorney Docket No. 730301-2013 :
For: METHOD AND APPARATUS FOR
STORING WEB SITE DATA BY WEB SITE
DIMENSIONS AND GENERATING A WEB
SITE HAVING COMPLEMENTARY
ELEMENTS

**OFFICE OF PETITIONS
ON PETITION**

This is a decision on the petition under 37 CFR 1.47(a), filed October 1, 2010. The petition will be treated under 37 CFR 1.47(a) with respect to Andrew Dean and as a constructive petition under CFR 1.183, requesting waiver of 37 CFR 1.63 and 1.67, which requires all of the joint inventors to execute a supplemental declaration, with respect to John Underwood, Paul Neilson, Hanson Char, David Shing, Peter Horner, Mark Underwood, and Darren Slaney.¹

The petition under 37 CFR 1.47(a) is **DISMISSED**.

The petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a) and 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67" and may include an oath or declaration executed by the inventors. **Failure to respond will result in abandonment of the application.**

With respect to Andrew Dean: A grantable petition under 37 CFR 1.47(a) requires:

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the petition fee of \$200, and
- (4) the last known address of the omitted inventor(s).

¹ Once an application has received an executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal or unavailability to sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

This petition lacks item (1) above.

As to item (1), the applicable statute (35 U.S.C. § 116) requires that a “diligent effort” have been expended in attempting to find or reach the non-signing inventor. *See* MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate non-signing inventor Andrew Dean, such that the declaration can be accepted under 37 CFR 1.47(a). Where inability to find or locate a named inventor is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor.

Petitioner has not demonstrated that all efforts were expended in trying to locate non-signing inventor Dean. A package enclosing the application and a declaration mailed to his last known address was returned. Petitioner performed a White Pages Internet search for Mr. Dean and obtained a “hit”. It is not clear how, or if, petitioner followed up with the White Pages hit. The petition fails to indicate that correspondence was ever mailed unsuccessfully to the White Pages hit. Petitioner should mail correspondence to that address, return receipt requested, along with a cover letter of instructions *which includes a deadline or a statement that no response will constitute a refusal*. This sort of ultimatum lends support to a finding of refusal by conduct.

Petitioner should state whether he has access to inventor Dean’s personnel records and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? If other attempts to locate or reach the inventor, e.g., through other Internet search engines, *using a broader geographical search area*, co-workers, E-mail, or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. Print outs of unsuccessful Internet searches should be submitted. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that a non-signing inventor’s conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever a non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

As to John Underwood, Paul Neilson, Hanson Char, David Shing, Peter Horner, Mark Underwood, and Darren Slaney: While this waiver petition is not a petition under 37 CFR 1.47, it is evaluated in much the same way a Rule 47 petition is. Therefore, a grantable petition requires:

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) a petition fee, and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1).

With respect to item (1), petitioner has failed to establish that Inventors Neilson, J. Underwood, Horner, M. Underwood, and Char cannot be located. The petition shows that a multiple deliveries of a package containing the application papers and a supplemental declaration to Inventors Neilson, J. Underwood, Horner, M. Underwood, and Char's last known addresses were attempted. The deliveries were unsuccessful. It is noted that Inventors Horner and Char have apparently moved.

A showing of **diligence** is critical in establishing an inventor cannot be located or reached.

Address hits were obtained via Internet searches for Inventors J. Underwood, Horner, and M. Underwood. It is noted that a PeopleSmart search was conducted for one of the inventors and White Pages searches were conducted for the others. Sponsored links listed a number of leads as to some of the inventors' whereabouts. Did petitioner follow up with these leads?

The petition fails to indicate that correspondence was ever mailed unsuccessfully to the Internet hits. Petitioner should mail correspondence to those address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

Petitioner should state whether he has access to the inventors' personnel records and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? If other attempts to locate or reach the inventors, e.g., through other Internet search engines, *using a broader search area*, co-workers, E-mail, or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. Print outs of unsuccessful Internet searches should be submitted. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where

there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the petitioner that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever a non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

With respect to Inventors Slaney and Shing, it is not clear if packages to their last known addresses were delivered. Please clarify the record in a reconsideration petition. If they were not delivered, additional efforts to locate them are required.

Regarding fees, petitioner submitted \$200.00. The current Rule 183 petition fee is \$400.00. Accordingly, deposit account no. 50-0320 will be charged \$400.00.

Further correspondence with respect to this matter should be delivered through one of the following mediums:


By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

By internet: EFS-Web
 www.uspto.gov/ebs/efs_help.html
 (for help using EFS-Web call the
 Patent Electronic Business Center
 at (866) 217-9197)

Telephone inquiries should be directed to the undersigned at (571) 272-3230.


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